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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,481	08/13/1999	TOHRU FUSHIKI	35859.1	4398

7590

01/12/2004

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EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/367,481	Applicant(s) FUSHIKI ET AL.	
	Examiner Susan Coe	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-31, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-31, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed October 6, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 24-31, 40, and 41 are pending.

Claim Rejections - 35 USC § 103

3. Claims 24-31, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3,764,692 in view of US Pat. No. 5,536,516 and McCarty (Medical Hypotheses (1995), vol. 45, pp. 247-254) for the reasons of record set forth in the previous Office actions.

Applicant's amended claims are drawn to a method of enhancing the ability of a subject to continuously perform physical activity by administering a composition comprising hydroxycitric acid. In response to the new 102 rejection made by the Board of Appeals, applicant has submitted these claims to define that the subject is actively participating in exercise. In view of these new claims, the invention is still considered obvious based on the combination of US '642, US '516, and McCarthy for the reasons stated below and of record.

US '692 is drawn to an orally administered composition for treating obesity. The active ingredient of the composition is (-) hydroxycitric acid derived from the fruit of *G. cambogia*. The (-) hydroxycitric acid can also be used in lactone form or as a pharmaceutically acceptable salt such as the sodium or potassium salt of the acid (column 1, lines 27-46; column 2, lines 1-5; and claims 1 and 7).

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The hydroxycitric acid free acid, salt, and lactone can be administered with any pharmaceutically acceptable carrier such as water, gelatin, starch, or vegetable oil (see column 2, lines 26-35). All of these carriers are considered food.

While this reference teaches orally administering the claimed (-) hydroxycitric acid and derivatives, it does not teach extracting the (-) hydroxycitric acid from *G. indica* or *G. atroviridis*.

US '516 teaches that free acid and lactone forms of hydroxycitric acid can also be extracted from the fruit of *G. indica* and *G. atroviridis* and *G. cambogia* (see column 1, lines 7-10). These compounds are used for oral administration. This disclosure shows that the presence of orally administrable hydroxycitric acid in extracts from *G. indica* and *G. atroviridis* was known in the art at the time of the invention. Based on the disclosure by US '516 that hydroxycitric acid can be extracted from *G. indica* and *G. atroviridis* as well as the *G. cambogia* disclosed by US '692, a person of ordinary skill in the art would have had a reasonable expectation that hydroxycitric acid could be successfully extracted from *G. indica* and *G. atroviridis*. Therefore, the artisan of ordinary skill would have been motivated to use *G. indica* and *G. atroviridis* as a source of hydroxycitric acid based on the disclosure by US '516.

US '692 and US '516 teach hydroxycitric acid compositions; however, they do not teach administering the compositions for increasing endurance during exercise. McCarty discloses that hydroxycitric acid compositions from garcinia used for inducing weight loss may also be used to increase endurance (see page 250). The hydroxycitric acid compositions of US '692 and US '516 are both used for reducing body weight. McCarty also teaches that hydroxycitric acid may increase endurance during exercise and aid in liver-glycogen loading prior to prolonged exercise

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(see page 250). McCarty's disclosure shows that hydroxycitric acid compositions administered for weight loss can also be used to increase endurance during exercise. Based on McCarty's disclosure, a person of ordinary skill in the art would have had a reasonable expectation that the hydroxycitric acid compositions taught in US '692 and US '516 would have been useful in increasing endurance. Therefore, an artisan of ordinary skill would have been motivated to use the hydroxycitric acid compositions taught by US '692 and US '516 in the method taught by McCarty.

4. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Please note that on January 20, 2003, these contact phone numbers will change. Examiner Coe's new phone number will be (571) 272-0963. Supervisory Examiner Brumback's new phone number will be (571) 272-0961. However, the fax phone number will remain (703) 872-9306.

Susan Coe, Examiner
January 7, 2004



FRANCISCO PRATS
PRIMARY EXAMINER